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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,273	10/09/2001	Nick Nassiri		5689

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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT PAPER NUMBER

2134

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/973,273	Applicant(s) NASSIRI, NICK	
	Examiner Matthew Heneghan	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-77 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 20 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. In response to the initial office action, Applicant attempted to amend claims 1, 3, 4, 8, 9, 20-26, 31-33, 43-49, 51, 54, 59, 60, 62-64, 66, 68, 69, and 71-74; cancel claims 6, 7, 29, 57, 58, and 75-77; and add claim 78. These claims were not entered in the previous office action and have not been entered in this action for the reasons stated below.
3. Applicant has still not completely complied with the issues concerning new matter raised in previous office actions. Due to incorporation of large amounts of new matter into the claims and the specification, the amendments to the claims filed 6 December 2005 continue to stand as having NOT been entered, and are not being considered above and beyond the rejections being stated under 35 U.S.C. 112, first paragraph, below. The rejections of the original claims under 35 U.S.C. 103 are being repeated.

Drawings

4. The drawings were received on 20 March 2006. These drawings are not acceptable.
5. All of the drawings submitted on 20 March 2006 contain aspects not in the original disclosure, and are being treated as new matter. These drawings are not being further examined.
6. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

7. The amendment filed 16 May 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The proposed changes to the specification include new terms or modifications to definitions of terms in the original disclosure, or are otherwise not properly supported by the original disclosure. Examples include, but are not limited to:

In the replacement paragraphs 16-20, Applicant has added the need for live-stream methods, and the verification (rather than the authentication) of items in the first two paragraphs; the last three paragraphs are not supported by the disclosure.

In the replacement paragraphs 62-64, Applicant has significantly changed the brief descriptions of the original drawings and added references to drawings that did not exist in the original disclosure.

In the replacement paragraphs 178-184, Applicant has deleted or changed several term definitions that affect the manner in which the remainder of the disclosure should be considered, and added new term definitions that likewise affect the remainder of the disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-5, 8-28, 30-56, 59-74, and 78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amendments to the disclosure have modified the definitions of certain terms used in the claims from the original disclosure, including all of the independent claims. These terms include, but are not limited to: "VVSC," "authoritative document," and "notary public."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0002485 to Bisbee et al. in view of U.S.

Patent No. 5,712,914 to Aucsmith further in view of U.S. Patent No. 6,317,777 to Skarbo et al.

NOTE: This rejection is based upon Applicant's original disclosure.

Bisbee discloses a system wherein a set of parties in a networked architecture, using Transfer Agents, use a server, a Document Authentication System (DAS), in conjunction with a notary, called a TCU. Electronic documents are transmitted to the TCU via a communication means (see paragraph 69). The Transfer Agent relays to the TCU a set of verification data, including digitized hand-written signatures, biometric information, and a digital signature (certificate), which have been acquired by the transfer agent from the appropriate means (see paragraph 70).

Upon verification of the information provided by the transfer agents, the TCU appends a certificate to the document to confirm authenticity, but does not append the biometric data, or certificates supplied by the Transfer Agents.

Aucsmith discloses certificate extensions including logos, handwritten signatures, and biometric data, and states that these verify that the signers are really who they say they are (see column 5, line 40 to column 9, line 47). Any additional data derived by this process would constitute a digital signature.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Bisbee by appending the logos, handwritten signatures, and biometric data to the certificates on produced documents, as disclosed by Aucsmith, to verify that the signers are really who they say they are.

Bisbee's TCU may be instructed to encrypt the produced document before distribution (see paragraph 71).

Bisbee also does not explicitly specify the means by which the users are transacting.

Skarbo discloses a document collaboration system via videoconferencing, via the web or otherwise, supervised by a document server (the VVSC) (see column 2, lines 40-62). Skarbo further suggests that this reliably gets conference data to conference participants (see column 1, lines 46-48).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to perform the contract negotiation via videoconference, via the web or otherwise, as disclosed by Skarbo, as this reliably gets conference data to conference participants.

Aucsmith also discloses the appending of retinal prints and hand geometry.

Response to Arguments

10. Applicant's arguments filed 6 December 2005 have been fully considered but they are not persuasive.

Regarding the subject of new matter, changes to the specification may be made only if they correct matter in a manner that would be obvious to one skilled in the art who was reading the original disclosure, or if they adds matter is intrinsic, implicit, or inherent in the original disclosure. Matter may not be deleted from a specification if its

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absence changes the manner in which one skilled in the art would ascertain the remainder of the specification and/or the claims.

Regarding Applicant's argument that replacement paragraph 18 is supported by the original disclosure, one skilled in the art would not necessarily find this to be the case. New paragraph 18 teaches to the lack of notarization in prior art, whereas the original disclosure cited by the Applicant simply points out the notarization features of Applicant's invention; nowhere in the original disclosure was it asserted that this functionality was also missing from the prior art. New paragraphs 19 and 20 similarly make statements about the state of the prior art that were not made in the original disclosure; though the original disclosure did assert several deficiencies in the prior art, the shortcomings in the new paragraphs were not among them.

Regarding Applicant's argument that the cited art does not use a notary public, it is noted that Applicant's original specification specifically stated that a digital certificate constituted a notary public (see paragraph 180). Applicant appears have attempted to change that definition to the traditional dictionary definition (wherein a notary public is a person) by deleting the definition in the disclosure. Though it is a deletion, rather than an addition, of text, this action nonetheless is considered to be an introduction of new matter.

Regarding Applicant's arguments regarding Bisbee et al.'s rendering the claimed inventions to be unpatentable, Applicant's arguments are rendered moot because the amendments to the claims have not been entered; furthermore, several of Applicant's

arguments (regarding notaries public, for example) hinge on term definitions that are not consistent with Applicant's original disclosure.

Conclusion

11. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an

appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

12. Applicant is again reminded that new matter may be introduced in an application that is filed as a continuation-in-part of a copending application (i.e. an application that is not yet abandoned or granted). See MPEP 201.08, 711.01, and 711.04(a).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques, can be reached at (571) 272-6962.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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August 3, 2006


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